UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte STEVEN DENNIS FLINN and
NAOMI FELINA MONEYPENNY

_____

Appeal 2014-008696
Application 13/269,979[1]
Technology Center 3600

_____

Before JOSEPH A. FISCHETTI, BRUCE T. WIEDER, and
KENNETH G. SCHOPFER, *Administrative Patent Judges.*

WIEDER, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the
Examiner's rejection of claims 1–20. We have jurisdiction under
35 U.S.C. § 6(b).

We AFFIRM-IN-PART and enter a NEW GROUND OF
REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

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[1] According to Appellants, the real party in interest is ManyWorlds, Inc.
(Appeal Br. 3.)

CLAIMED SUBJECT MATTER

Appellants' claimed invention "relates to extending the business process paradigm so as to make processes more explicitly adaptive over time." (Spec. 1.)

Claims 1, 9, and 18 are the independent claims on appeal. Claim 1 is illustrative of the subject matter on appeal. It recites:

> 1. A method, performed by a computer processor configured to execute steps comprising:
>
> accessing a plurality of usage behaviors from a computer-implemented usage function, wherein the plurality of usage behaviors are associated with a user's use of a mobile processor-based device; and
>
> delivering a media instance to the user of the mobile processor-based device, wherein the media instance comprises a plurality of songs, wherein the plurality of songs are automatically selected for inclusion in, and arranged in, the media instance in accordance with an inference of a preference based, at least in part, on the plurality of usage behaviors.

REJECTIONS

Claims 1–8 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.[2]

Claims 1–20 are rejected under 35 U.S.C. § 102(b) as anticipated by Chislenko (US 6,041,311, iss. Mar. 21, 2000).

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[2] The Final Action withdraws the previous rejection of claims 9–20 under § 101. That rejection was based on claims 9–20 being directed to "*software per se*" and was "overcome by the amendments to the subject claims." (Final Action 5.) Therefore, we view the statement that "[p]revious rejection(s) of claims 1–20 are rejected under 35 U.S.C. 101 . . . are maintained herein" as a typographical error. (*See id.* at 3.)

ANALYSIS

The § 101 rejection of claims 1–8

Claim 1 is rejected as being directed to patent-ineligible subject matter. (Final Action 3–5.) The Examiner determines that "[c]laim 1 is directed to a method/process in which the claimed steps merely recite actions a human actor performs on a computing device. Accordingly, the claimed steps are limited to a series of abstract descriptions of human actions. Claim 1 is directed to an abstract idea." (*Id.* at 4.) Additionally, the Examiner determines that

> the recited steps are merely limited to "accessing a plurality of usage behaviors . . ." and ". . . delivering a media instance . . .". The retrieval and delivery of data, as claimed in the noted steps, fails to tie the recited processor to the inventive step of the method, namely, the arrangement and selection of songs based on an inference preference.

(Answer 6.) The Examiner further determines that there is no "active step in the claimed method in which the media instance is arranged by the recited device or an otherwise identified processor." (*Id.* at 6–7.)

Appellants disagree and argue that claim 1 "depends fundamentally on songs being 'automatically selected for inclusion in, and arranged in, the media instance.'" (Appeal Br. 11.) Appellants further argue that "automatically" is "an action being fully performed by a computing device, as opposed to being performed by, or even involving, a human actor." (*Id.*)

The claimed method comprises the steps of accessing usage behaviors and delivering a media instance. We agree with the Examiner that it is unclear from the claim what selects and arranges the songs in the media instance. We also agree with the Examiner that the steps of accessing and delivering are steps a human actor can perform. In short, claim 1 is directed

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to the abstract idea of accessing information from a user and delivering responsive information in the form of a plurality of songs. *See Affinity Labs of Texas, LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1269–70 (Fed. Cir. 2016); *see also Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 1016).

Additionally, the claim does "not include any requirement for performing the claimed functions . . . by use of anything but entirely conventional, generic technology." *See Electric Power Grp.*, 830 F.3d at 1356. Therefore, we agree with the Examiner that claim 1 is directed to patent-ineligible subject matter. *See Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014). Claims 2–8, which depend from claim 1, are not separately argued with regard to this § 101 rejection. Therefore, claims 2–8 fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

New ground of rejection under § 101 of claims 9–20

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a NEW GROUND OF REJECTION against claims 9–20 under 35 U.S.C § 101.

Subsequent to the filing of briefs in this appeal, the Supreme Court decided *Alice*. *Alice* applies a two-part framework, earlier set out in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012), "for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Alice Corp.*, 134 S. Ct. at 2355.

Under the two-part framework, it must first be determined if "the claims at issue are directed to a patent-ineligible concept." *Id.* If the claims are determined to be directed to a patent-ineligible concept, then the second

part of the framework is applied to determine if "the elements of the claim . . . contain[] an 'inventive concept' sufficient to 'transform' the claimed abstract idea into a patent-eligible application." *Id.* at 2357 (citing *Mayo*, 132 S. Ct. at 1294, 1298). Therefore, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

Although the Court in *Alice* did not elaborate on how it made its finding as to what the claims were directed, we find that this case's claims themselves and the Specification provide enough information to inform one as to what they are directed.

Independent claims 9 and 18 are similar to claim 1 as they are directed to the idea of obtaining information from a user and using that information to select a plurality of songs. For the reasons discussed above with respect to claim 1, we determine that claims 9 and 18, and dependent claims 10–17, 19, and 20, are directed to an abstract idea.

We now apply the second part of the framework to determine if "the elements of the claim . . . contain[] an 'inventive concept' sufficient to 'transform' the claimed abstract idea into a patent-eligible application." *Alice Corp.*, 134 S. Ct. at 2357 (citing *Mayo*, 132 S. Ct. at 1294, 1298).

As is the case with claim 1, the claims do not provide anything significant to differentiate the claimed process from ordinary mental steps. *See Electric Power Grp.*, 830 F.3d at 1355. The claims "do not require an arguably inventive set of components or methods, such as measurement devices or techniques." *Id.* The introduction into the claims of a processor-based device or a computer-implemented function does not alter the analysis at step two.

> [T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea "while adding the words 'apply it'" is not enough for patent eligibility. Nor is limiting the use of an abstract idea "'to a particular technological environment.'" Stating an abstract idea while adding the words "apply it with a computer" simply combines those two steps, with the same deficient result. Thus, if a patent's recitation of a computer amounts to a mere instruction to "implemen[t]" an abstract idea "on . . . a computer," that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our §101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of "additional featur[e]" that provides any "practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself."

Alice Corp., 134 S. Ct. at 2358 (citations omitted).

"[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer." *Id.* at 2359. They do not. Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional and adds no inventive concept. Nor do the claims offer detail about the computer system. In short, the claim steps/limitations do no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the processor and computer components of Appellants' method add nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellants' claims simply recite the concept of obtaining information from a user and using that information to select songs. The claims do not, for example, purport to improve the functioning of either the processor or the

computer. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of obtaining information from a user and using that information to select songs. That is not enough to transform an abstract idea into a patent-eligible invention. *See id.* at 2360; *see also Electric Power Grp.,* 830 F.3d at 1353–56.

The § 102(b) rejection of claims 1–20

The Examiner finds that Chislenko discloses "contributing a plurality of usage behaviors to a computer-implemented usage function through use of a mobile processor-based device; and interacting with a media instance executed on the mobile processor-based device (Chislenko et al.; col. 12, lines 1–35 and col. 20, lines 40–67)." (Final Action 6.)

Appellants argue that "the Examiner's citations of Chislenko do not teach the claim elements, 'delivering a media instance to the user of the mobile processor-based device, wherein the media instance comprises a plurality of songs.'" (Appeal Br 13.)

Claim 1 recites "delivering a media instance to the user of the mobile processor-based device, wherein the media instance comprises a plurality of songs." The Examiner does not indicate where Chislenko discloses *delivering* a media instance to the user where the media instance comprises a plurality of songs. Therefore, we are persuaded that the Examiner erred in finding that Chislenko anticipates claim 1 and in finding that Chislenko anticipates claims 2–8, which depend from claim 1.

The Examiner does not separately discuss independent claims 9 and 18 except to say:

> Claims 9–20 substantially repeat the limitations of claims 1–8 as directed to an enabling system. With respect to this element, Chislenko et al. disclose enabling the disclosed method employing analogous systems/devices. Accordingly, claims 9–20 are rejected under the applied teachings, *conclusions of obviousness*, and rationale/motivation to modify/combine as discussed above with respect to claims 1–8.

(Final Action 9, emphasis added.) As an initial matter, we note that claims 1–20 are rejected as *anticipated* by Chislenko. (*Id.* at 6.) Therefore, we treat the Examiner's reference to "conclusions of obviousness" with respect to claims 1–8 as a typographical error.

Independent claim 9 recites:

> 9. A computer-implemented system, comprising one or more processor-based devices configured to execute:
>   a computer-implemented usage function that accesses a plurality of usage behaviors associated with a user interacting with a first media instance, wherein the first media instance comprises a first plurality of songs; and
>   a media instance-generating function executed on a processor-based device that selects and arranges a second plurality of songs for inclusion in a second media instance, wherein the selection and arrangement of the plurality of songs are in accordance with an inference of a preference that is based, at least in part, on the plurality of usage behaviors.

Appellants argue that the Examiner does not indicate where Chislenko teaches "the claim elements, 'a user interacting with a first media instance, wherein the first media instance comprises a first plurality of songs,' nor 'a media instance-generating function executed on a processor-based device that selects and arranges a second plurality of songs for inclusion in a second media instance.'" (Appeal Br. 26.)

The Examiner does not indicate where Chislenko discloses accessing a plurality of usage behaviors associated with a user interacting with a first

media instance where the media instance comprises a plurality of songs.
Nor does the Examiner indicate if the type of content of the media instance
is treated as non-functional descriptive matter. We decline to make that
determination in the first instance. Therefore, we are persuaded that the
Examiner erred in finding that Chislenko anticipates claim 9 and in finding
that Chislenko anticipates claims 10–17, which depend from claim 9.

Independent claim 18 recites, in relevant part: "a media instance-
generating function executed on a processor-based device that selects a
plurality of songs for sequential arrangement in a media instance, wherein
the selection is in accordance with an inference of a preference that is based,
at least in part, on a plurality of usage behaviors."

The Examiner does not indicate where Chislenko discloses a media
instance generating function that selects a plurality of songs for sequential
arrangement in a media instance. Therefore, we are persuaded that the
Examiner erred in finding that Chislenko anticipates claim 18 and in finding
that Chislenko anticipates claims 19 and 20, which depend from claim 18.

DECISION

The Examiner's rejection of claims 1–8 under 35 U.S.C. § 101 is
affirmed.

The Examiner's rejection of claims 1–20 under 35 U.S.C. § 102(b) is
reversed.

We enter a new ground of rejection of claims 9–20 under 35 U.S.C.
§ 101.

This decision contains a new ground of rejection pursuant to
37 C.F.R. § 41.50(b). Section 41.50(b) provides that, "[a] new ground of

rejection pursuant to this paragraph shall not be considered final for judicial review." Section 41.50(b) further provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THIS DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)